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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/704,904

11/02/2000

Richard Hayton

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John D. Lanza, Esq.
LAHIVE & COCKFIELD, LLP
28 State Steet
24th Floor
Boston, MA 02109-1784

EXAMINER

POLLACK, MELVIN H

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 04/15/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/704,904

Applicant(s)

HAYTON ET AL.

Examiner

Melvin H Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2,3,5,6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached office action.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because the abstract is too long, and because it exceeds 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 26, 27 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 26 recites the limitation "the system" in claim 26. There is insufficient antecedent basis for this limitation in the claim. Further, the claim as currently drawn is dependent on itself, and shows no connection to any independent claim. Examiner requires that the claim be corrected to reflect the proper dependency. For this office action, the examiner will consider claim 26 to be dependent on claim 22.

6. Claim 27 inherits the claim 26 deficiencies.

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7. Claim 29 recites the limitation "the system" in claim 29. There is insufficient antecedent basis for this limitation in the claim. Further, the claim as currently drawn is dependent on itself, and shows no connection to any independent claim. Examiner requires that the claim be corrected to reflect the proper dependency. For this office action, the examiner will consider claim 29 to be dependent on claim 22.

8. Claims 3-5, 15-17, and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 3-5, 15-17, and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the people or components that perform "selective execution." It is unclear if this is a decision by the server, the client, or the user. It is further unclear what mechanism is used to determine whether or not to execute, and the results of such execution. The examiner strongly recommends amending the claims to clarify this issue.

10. Claims 10, 11, 20, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 10, 11, 20, and 21 provides for the use of several components for a process listed in the preamble, but, since the claim does not set forth any steps involved in the method/process,

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it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. These claims clearly omit essential elements of the process.

Claim Rejections - 35 USC § 101

12. Claims 10, 11, 20, and 21 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). A claim listing a few parts and stating in the preamble a purpose, i.e. of a perpetual motion machine, would be rejected without a description of how to use each part. Likewise, a claim listing a few parts and stating in the preamble a purpose of partial page regeneration of a transferred page makes the claims overly broad and lack both specific functionality and required steps for doing so.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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14. Claims 1-5, 9-17, 20-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Hawes (6,094,662).

15. For claim 1, Hawes teaches a method (see abstract) for partial page regeneration (col. 1, lines 5-15) of a transmitted page (col. 2, lines 55-67) by a server (Fig. 1, #130), said method comprising:

- a. Receiving page generation code that generates a page (col. 1, lines 40-56; col. 2, lines 20-30);
- b. Transmitting said page (col. 4, lines 45-47) to a client (Fig. 1, #110) for display (Fig. 1, #140);
- c. Associating a portion of said transmitted page with a code fragment of said page generation code (col. 2, lines 55-61; col. 4, line 50 – col. 5, line 13); and
- d. Executing said associated code fragment of said code to regenerate said portion of said transmitted page (col. 5, lines 20-25).

16. For claim 2, Hawes teaches transmitting said regenerated page portion to said client (Fig. 5, S2600) for incorporation into said transmitted page (Fig. 5, S2700 and S2800).

17. For claim 3, Hawes teaches the step of manipulating execution of said page generation code to enable selective execution of said associated code fragment (Fig. 5, S2500). The page is refreshed only if changes are made, and only to the flagged and selected portions.

18. For claim 4, Hawes teaches that the step of manipulating further comprises intercepting communication between said associated code fragment (Fig. 4, S1500) and other parts of said code (Fig. 6, S3200) to enable execution of less than said entire page generation code (Fig. 6,

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S3600; col. 5, lines 25-45). The page is refreshed only due to coordination between the non-cacheable portions flag and a timer to determine when to check the server's page status.

19. For claim 5, Hawes teaches that the step of manipulating further comprises adding additional code (Fig. 3, 213) to operate with said page generation code to enable selective execution of said associated code fragment (col. 5, lines 45-57). The page is refreshed due to a code to form a refresh button on the page, i.e. in Java, that checks the status of the non-cacheable data upon a user press. Added code to insert a timer would also teach this limitation.

20. For claim 9, Hawes teaches that said page is formatted as a Hypertext Markup Language (HTML) page (col. 1, lines 40-45).

21. For claims 10, 11, 20 and 21, Hawes teaches that there exists a client (Fig. 1, #110), a client transceiver (Fig. 1, #180), a server transceiver (Fig. 1, #120), a partial page regenerator (Fig. 1, #130), and an external page code source (Fig. 1, #212). As stated, these claims teach no other limitations, including any limitations to explain the use and/or operation of these components.

22. Claim 12 is drawn to a hardware system that implements the method drawn in claim 1, with added limitations from claim 10. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 1 and 10 are rejected, claim 12 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request. It is the belief of the examiner that, due to the existence of claim 12, claim 10 should be cancelled.

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23. Claim 13 is drawn to the limitations in claim 11. Therefore, since claim 11 is rejected, claim 13 is also rejected for the reasons above. It is the belief of the examiner that, due to the existence of claim 13, claim 11 should be cancelled.

24. For claim 14, Hawes teaches that said partial page regenerator is further configured to send said regenerated portion to said transceiver for transmission to said client (Fig. 4, S1400).

25. Claims 15-17 are drawn to a hardware system that implements the method drawn in claims 3-5. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 3-5 are rejected, claims 15-17 are also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

26. Claim 22 is drawn to a hardware system that implements the method drawn in claim 1, with added limitations from claim 20. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 1 and 20 are rejected, claim 22 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request. It is the belief of the examiner that, due to the existence of claim 22, claim 20 should be cancelled.

27. Claim 23 is drawn to the limitations in claim 21. Therefore, since claim 21 is rejected, claim 23 is also rejected for the reasons above. It is the belief of the examiner that, due to the existence of claim 23, claim 21 should be cancelled.

28. Claim 24 is drawn to the limitations in claim 14. Therefore, since claim 14 is rejected, claim 24 is also rejected for the reasons above.

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29. Claims 25-27 are drawn to a server system that implements the method drawn in claims 3-5. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 3-5 are rejected, claims 25-27 are also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

Claim Rejections - 35 USC § 103

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claims 6-8, 18, 19, 28, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawes as applied to claims 1-5, 9-17, 20-27 above, and further in view of Jois et al. (6,112,242).

32. For claim 6, Hawes does not expressly disclose the step of associating further comprises executing a code fragment of said page generation code to generate an output, and identifying with an identification tag said generated output of said executed code fragment to identify which portion of said transmitted page is created by said executed code fragment. Hawes does disclose that the system may accommodate any form of tagging to delineate updatable content matter (col. 5, lines 3-7). Jois teaches a method (see abstract) of serving web pages (col. 1, lines 20-40) in which a page is split up (col. 2, lines 40-60) so that one portion may be updated without updating other portions (col. 2, line 64 – col. 3, line 3; col. 5, lines 20-22). Jois also demonstrates the above limitations (col. 5, lines 40-60; col. 6, lines 5-15). At the time the

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invention was made, one of ordinary skill in the art would have used Jois in a Hawes system in order to provide Hawes with a method of determining non-cacheable data and to provide an improved interactive experience (col. 2, lines 33-36).

33. For claim 7, Hawes does not expressly disclose the step of identifying further comprises inserting said identification tag at the beginning and the ending of said generated output. Jois teaches this method as well (col. 1, lines 40-50; col. 5, lines 50-55). At the time the invention was made, one of ordinary skill in the art would have used Jois in a Hawes system in order to provide Hawes with a method of determining non-cacheable data and to provide an improved interactive experience (col. 2, lines 33-36).

34. For claim 8, Hawes teaches the use of Java (col. 1, lines 47-55), but does not expressly disclose that said code is formatted as a servlet. Jois teaches this method as well (col. 6, lines 63-67). At the time the invention was made, one of ordinary skill in the art would have used Jois in a Hawes system in order to provide Hawes with a method of determining non-cacheable data and to provide an improved interactive experience (col. 2, lines 33-36).

35. Claim 18 is drawn to a hardware system that implements the method drawn in claims 6 and 7. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 6 and 7 are rejected, claim 18 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

36. For claim 19, Hawes does not expressly disclose that said partial page regenerator is further configured to store a relationship between said portion of said page and said code fragment of said code that generates said portion. Jois teaches this limitation (Fig. 3, #240). At the time the invention was made, one of ordinary skill in the art would have used Jois in a Hawes

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system in order to provide Hawes with a method of determining non-cacheable data and to provide an improved interactive experience (col. 2, lines 33-36).

37. Claim 28 is drawn to a hardware system that implements the method drawn in claims 6 and 7. It is well known in the art that a system implementation is functionally equivalent to the underlying method. Therefore, since claims 6 and 7 are rejected, claim 28 is also rejected for the reasons above. A teaching that shows the functional equivalence will be included upon request.

38. Claim 29 is drawn to the limitations in claim 19. Therefore, since claim 19 is rejected, claim 29 is also rejected for the reasons above.

Conclusion

39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (703) 305-4641. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP

08 March 2004



RUPAL DHARIA
SUPERVISORY PATENT EXAMINER